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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,310	12/12/2003	Tomohiro Shinoda	LIL-0002	9083
23353 7590 07/22/2008 RADER FISHMAN & GRAUER PLLC LION BUILDING 1233 20TH STREET N.W., SUITE 501 WASHINGTON, DC 20036				
EXAMINER				
DHILLON, MANJOT K				
ART UNIT		PAPER NUMBER		
3714				
MAIL DATE		DELIVERY MODE		
07/22/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/733,310

**Applicant(s)**

SHINODA, TOMOHIRO

**Examiner**

MANJOT K. DHILLON

**Art Unit**

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5-7 and 9-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-7, and 9-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/14/08 has been entered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 language includes both a method and apparatus claim language. Apparatus language starts with "a gaming machine comprising", method language starts with "wherein, when each trading card is heated".

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3714

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1, 3, 5-7, and 9-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muroi (US 2002/0052238) and Nakamura (US 6468162) in further view of Naito et al. (US 6010808).

7. Concerning claims 1, 7, and 11, Muroi teaches a gaming machine comprising one or more trading cards, each one of the one or more trading cards storing a unique set of character data and having a unique image portrayed thereon [0018/0022]; three slots into which one or more trading cards can be inserted by a player, each trading card storing a set of character data and/or a data reading unit for reading character data from the one or more trading cards which are inserted into the data reading unit by a player, each trading card storing a set of character data [0018/0022]; a card reader which reads character data from the inserted trading cards [claim 1, lines 13-17].

Muroi discloses a controller [11: CPU, which functions as a controller] which executes a predetermined computer program [pg. 5, right col., claim 8, lines 1-4], the controller being connected to the card reader and the payout device [Fig. 1: the CPU is

**connected to the reader/writer through the data/address bus (1K) and the transmission/reception interface, the payout device is the card writer**]; wherein the controller causes the card reader to read the character data **[claim 8, lines 1-7]**, an advancing unit/device for advancing a game based on the read character data **[0018/0024]**; a combining unit/device for combining at least two sets of character data when a first predetermined condition is satisfied in the advanced game **[0006/0024/0032]**. Two sets of character data are a new fighting outfit combined with an old character. The predetermined condition is the round of the game. Nakamura also teaches combining at least two sets of character data **[column 10, lines 10-23]**. Muroi teaches a determining unit/device for determining at least one set of character data of a reward trading card based on the combined character data **[claim 8, lines 11-14; 0006/0018/0032]**; a payout unit for paying out the reward trading card to the player, the reward trading card storing the determine set of character data **[0039/0040; claim 8, lines 16-18; claim 4, lines 5-9]**. Muroi does not specifically disclose a payout; however the reward card obtains payout via game data being written on the card. Further, Nakamura teaches the characters data is paid out **[column 10, lines 40-50]**. Nakamura teaches a printing unit **[column 2, lines 53-67]**. Muroi and Nakamura lack details of the layers on the trading card.

Naito et al. teaches each card having a substrate layer, a coloring layer laminated onto the substrate layer and a re-writable layer laminated onto the coloring layer **[column 16, line 66- column 17, line 12 and column 19, line 55- column 21, line 10]**. Naito et al. teaches wherein, when each card is heated to a specified

temperature, the rewritable layer becomes transparent and the coloring layer becomes blackened and when the transparent layer and the blackened coloring layer is irradiated with a specified light pattern, the rewritable layer is selectively made non-transparent and the specified light pattern is illustrated on the trading card **[column 18, line 7-column 19, line 52]**.

Concerning claim 3, Muroi teaches the payout unit that includes writing unit for writing the determine set of character data in the reward trading card **[0039/0040; claim 8, lines 16-18; claim 4, lines 5-9]**. Muroi does not specifically disclose a payout; however the reward card obtains payout via game data being written on the card. Further, Nakamura teaches the characters data is paid out **[column 10, lines 40-50]**.

Concerning claim 5, Nakamura discloses the set of character data, which includes capability and attribute values **[col. 6, lines 17-25]**.

Concerning claim 6, Nakamura further discloses the payout unit **[col. 13, lines 18-19]** that includes printing unit for printing an image of the determined set of character data on a surface of the reward trading card **[col.13, lines 6-19]**.

Concerning claim 9 (see Examiner's rejection for claims 1, 7 and 11), Muroi discloses a method for controlling a gaming machine comprising steps of: providing one or more trading cards; insert the one or more trading cards into the gaming machine **[0018/0022]**; reading character data from two inserted trading cards, each trading card storing a set of character data and having a unique image printed thereon **[claim 8, lines 5-7; 0018/0022]**; an advancing unit/device for advancing a game based on the read character data **[0018/0024]**; receiving an instruction of combining the character

data, when a first prescribed condition is satisfied in the advanced game **[0006/0032]**; combining at least two sets of character data in response to the instructions **[0006/0024/0032]**. Two sets of character data are a new fighting outfit combined with an old character. The predetermined condition is the round of the game. Nakamura also teaches combining at least two sets of character data **[column 10, lines 10-23]**. Muroi teaches determining at least one set of character data of a reward trading card based on the combined character data **[0006/0032; claim 8, lines 11-14]**; and writing the set of updated character data to the memory of reward trading card **[claim 8, lines 16-18; claim 4, lines 5-9; 0006/0032]**. During the course of game play, the two sets of read character data are combined. Muroi teaches a determining unit/device for determining at least one set of character data of a reward trading card based on the combined character data **[claim 8, lines 11-14; 0006/0018/0032]**; a payout unit for paying out the reward trading card to the player, the reward trading card storing the determine set of character data **[0039/0040; claim 8, lines 16-18; claim 4, lines 5-9]**. Muroi does not specifically disclose a payout; however the reward card obtains payout via game data being written on the card. Further, Nakamura teaches the characters data is paid out **[column 10, lines 40-50]**. Nakamura teaches a printing unit **[column 2, lines 53-67]**.

Concerning claim 10, Muroi discloses the method for controlling the gaming machine further comprising steps of: changing the character data based on the results of the game **[claim 8, claim 4, para. 0006 and para. 0032]**.

Concerning claim 12, Nakamura teaches comprising a changing unit for changing a number of combining set and a number of determining set **[column 10, lines 1-22]** in response to proceedings of the game. Muroi teaches the values and attributes written in the transponder vary by proceedings of the game **[0024]**.

Concerning claim 13, Muroi teaches a generating unit for generating a set of character data when a second predetermined condition is satisfied in the advanced game **[0006/0018/0024/0032]**. A second predetermined condition could be a third round of play.

Concerning claim 14, Nakamura teaches the combining unit combines the entirety of the read character data, and the determining unit determines the entirety of the rewarded character data based on the combined character data **[column 10, lines 1-22]**.

Concerning claim 15, Nakamura teaches the combining unit combines a part of the read character data, and the determining unit determines the entirety of the rewarded character data based on the combined character data **[column 6, lines 11-29; column 10, lines 1-22]**.

Concerning claim 16, Nakamura teaches the combining unit combines the entirety of the read character data, and the determining unit determines a part of the rewarded character data based on the combined character data **[column 6, lines 11-29; column 10, lines 1-22]**.

Concerning claim 17, Nakamura teaches the combining unit combines a part of the read character data, and the determining unit determines a part of the rewarded



Art Unit: 3714

character data based on the combined character data [column 6, lines 11-29; column 10, lines 1-22].

Concerning claim 18, Muroi teaches further comprising an updating unit for updating the character data based on the results of the game [0006/0032; claim 8, lines 11-14].

It would be obvious to combine the Muroi trading card game with the Nakamura trading card game and the Naito rewritable thermal recording medium because all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

#### ***Examiner's Note***

The referenced citations made in the rejection(s) above are intended to exemplify areas in the prior art document(s) in which the examiner believed are the most relevant to the claimed subject matter. However, it is incumbent upon the applicant to analyze the prior art document(s) in its/their entirety since other areas of the document(s) may be relied upon at a later time to substantiate examiner's rationale of record. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). However, "the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...." In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

***Response to Arguments***

8. Applicant's arguments with respect to claims 1-3, 5-7, and 9-18 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MANJOT K. DHILLON whose telephone number is (571)270-1297. The examiner can normally be reached on Mon. - Thurs., 7 AM - 6 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert E Pezzuto/

Application/Control Number: 10/733,310

Page 10

Art Unit: 3714

Supervisory Patent Examiner, Art Unit 3714

/M. K. D./

Examiner, Art Unit 3714